C. Remarks

Claims 28-33 are presented for examination in lieu of claims 6-9, 15, 17-19 and 25-27, which have been cancelled without prejudice or disclaimer. Support for the new claims may be found in the cancelled claims as well as throughout the specification (e.g., First-Third Embodiments). No new matter has been added. Consideration of the present claims is expressly requested.

Claims 6, 7, 15, 17 and 19 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Application Publication No. 2002/0110823 A1 (Hogan). Claims 8, 9 and 27 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Hogan in view of U.S. Patent No. 6,362,004 B1 (Noblett). Claims 18 and 25 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Hogan in view of U.S. Patent No. 5,876,926 (Beecham). Claim 26 stands rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Hogan in view of U.S. Patent Application Publication No. 2001/0012537 A1 (Anderson).

Since all rejected claims have been cancelled, the above rejections are moot and should be withdrawn. Applicant would like to stress that the cancellation of claims 6-9, 15, 17-19 and 25-27 should not be viewed as a concession that these claims were unpatentable as alleged by the Examiner. The claims were cancelled without prejudice or disclaimer merely to expedite prosecution.

Applicant respectfully submits that the new claims are patentable over the cited art. The present invention, in pertinent part, is related to a testing method using a DNA microarray. In this method, for example as recited in claims 28-31, DNA collected

from a specimen is hybridized with a DNA microarray containing a first DNA probe group, which can be used to identify a subject providing the specimen, and a second DNA probe group, which can be used to test the specimen. As a result, test information and identification information can be generated at the same time from one specimen, ensuring a more accurate identification of the subject. This advantage is particularly important when specimens from many subjects are handled, for example, in a hospital or a laboratory.

When a test using a DNA microarray is performed, it requires various types of preprocessing, such as nucleic acid extraction, amplification, labeling, and the like. Accordingly, there is an increased probability of making a mistake, such as misidentifying the subject providing the sample through incorrect labeling. However, because identification information and test information are generated from one DNA microarray and one specimen, the possibility of making such mistakes is eliminated.

With respect to claim 32, this claim recites a testing method in which (i) hybridization pattern of a first and second DNA probe group is read; (ii) identity validation is performed based on a hybridization pattern corresponding to the first DNA probe group; and then (iii) test information is generated based on a hybridization pattern corresponding to a second DNA probe group (First and Second Embodiments). As recited in claim 33, the hybridization pattern of a second DNA probe is read and test information is generated based on a hybridization pattern corresponding to the second DNA probe group (Third Embodiment).

Accordingly, the test is not performed when a subject is not identified, which can enhance privacy protection of the subject. In particular, according to claim 33,

even the reading of the hybridization pattern of the second DNA probe group is not performed when the subject is not identified, which further enhances privacy protection.

The cited art neither discloses nor suggests all of the above-discussed features. Hogan is directed to methods for genomic screening of subjects. Specifically, Hogan teaches detecting a genetic marker indicative of a response to anesthesia and other perioperative or operative treatments and procedures to determine low-risk medication and/or surgical technique. Applicant respectfully submits that Hogan fails to disclose or suggest the above-discussed features of the presently claimed invention.

Beecham, Noblett and Anderson cannot provide the teachings missing in Hogan. Beecham is directed to a method and an apparatus for obtaining biometric data from a test subject for identification and testing a sample obtained from the test subject. However, as acknowledged previously by the Examiner, Beecham fails to disclose or suggest performing these two processes using a single microarray. Noblett was cited by the Examiner for a teaching of fiducial marks on a microarray. Anderson was cited for a teaching of using identifiers on microarrays. However, even if assumed, *arguendo*, that these references contain the alleged teachings, they still lack the same disclosure that is missing in Hogan and Beecham.

In conclusion, Applicant respectfully submits that the cited references, whether considered separately or in any combination, fail to disclose or suggest the presently claimed elements.

Wherefore, expedient allowance of the claims and passage to issue are respectfully requested.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

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